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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/667,779	09/22/2000	Nicolas Brogne	Q60742	1269

7590            09/22/2004

Sughrue Mion Zinn MacPeak & Seas PLLC  
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EXAMINER

DINH, KHANH Q

ART UNIT

PAPER NUMBER

2151

DATE MAILED: 09/22/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	09/667,779	BROGNE ET AL. <i>[Signature]</i>	
	<b>Examiner</b> Khanh Dinh	<b>Art Unit</b> 2151	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on 13 August 2004.
- 2a) This action is FINAL.      2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 1-12 is/are pending in the application.
  - 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_\_ is/are allowed.
- 6) Claim(s) 1-12 is/are rejected.
- 7) Claim(s) \_\_\_\_\_ is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.
 

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
  - a) All    b) Some \* c) None of:
    1. Certified copies of the priority documents have been received.
    2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
    3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)	4) <input type="checkbox"/> Interview Summary (PTO-413)
2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)	Paper No(s)/Mail Date. _____ .
3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date <u>7/8/04</u> .	5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)
	6) <input type="checkbox"/> Other: _____

## **DETAILED ACTION**

### ***Continued Examination Under 37 CFR 1.114***

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 8/13/2004 has been entered.
2. Claims 1-12 are presented for examination.

### ***Claim Rejections - 35 USC § 101***

3. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claim 10 is rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter since it lacks a computer readable medium and thus a program product comprised of machine-executable instructions (software) per se is not tangibly embodied.

### ***Claim Rejections - 35 USC § 102***

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

5. Claims 1, 2, 11 and 12 are rejected under 35 U.S.C. 102(e) as being anticipated by Nielsen (hereafter Nielsen), U.S. pat. No.5,870,548.

As to claim 1, Nielsen discloses a method of manipulating (modifying) a sent e-mail, addressed by a sender to a plurality of addressees (recipients), said sent email comprising an address header and a body (see fig.6B), said method comprising: routing a modification message (sending an action message to alter a previously sent message) over a data network (sending a message over Internet, see col.6 lines 17-43) to a server (sender's email system 200 fig.2), which operates independently from any e-mail processing means (sender email programs) associated with each of said addressees (recipients) [enabling sender at the Email Control System to modify message or delete a message after the message left the Email Control System (200

fig.2) to the remote Recipient Email System 202 fig.2 regardless of the sender email programs, see col.6 lines 44-67] and on which at least the body of said sent e-mail is stored, said modification message (409 fig.4) being sent by said sender (sender 407 fig.4) for modifying (altering) said e-mail body (using the senders programs to alter or to modify a previously sent messages located at the Email Receiver, see abstract, figs.2, 4, col.7 line 2-65).

modifying said e-mail body (allowing a sender to modify a previously sent email message) at said server (sender's email system 200 fig.2) according to said modification message (if sender select to modify the message, taking the sender to the modification path, see col.8 line 4 to col.9 line 22), if said e-mail body has not been accessed (inactive) on said server by any of said addressees (checking to see if the messages have been viewed by recipient, see fig.8B, col.12 lines 5-38), wherein the modification of said email body occurs at said server (sender's email system) independently of any email processing means associated with each of said addressees (recipients) [enabling sender to modify message or delete a message after the message left the Email Control System (200 fig.2) to the remote Email Receiver 202 fig.2 regardless of the sender email programs, see col.6 lines 44-67 and col.18 lines 1-29]

As to claim 2, Nielsen discloses modification of said email consists in deleting said e-mail body or modifying a part of said e-mail body (modifying or delete a email message), said sender being informed by said server if said modification has been

executed or not (using a modify database to track previously sent messages have been modified, see fig.8C, col.12 lines 39-64).

As to claim 11, Nielsen discloses a computer program product to be executed on a computer comprising computer program code embodied on a computer-readable medium, said computer program code means adapted to perform following steps:

composing a modification message (receiving a message containing a X-modify field including request for modifying a email message, see fig.11A, col.15 lines 41-51) for modifying an e-mail addressed to a plurality of addressees (e-mail recipients) and sent to a predefined server (200 fig.2) (see col.15 line 52 to col.16 line 25).

sending said modification message to said server to modify at least the body of the email sent to (modifying or deleting email message including the body) and stored on said predefined server if the email body has not been accessed on said server by any of addressee (modifying the previous sent email message if the message has not been seen, see fig.11B, col.16 line 61 to col.17 line 22), wherein the modification of said email body occurs at said server (sender's email system) independently of any email processing means associated with each of said addressees (recipients) [enabling sender to modify message or delete a message after the message left the Email Control System to the remote Email Receiver regardless of the sender email programs, see col.6 lines 44-67 and col.18 lines 1-29].

As to claim 12, Nielsen discloses a personal computer equipped with a computer program according to claim 11, computer program to be executed on a computer comprising computer program code embodied on a computer-readable medium, said computer program code means adapted to perform following steps:

composing a modification message (receiving a message containing a X-modify field including request for modifying a email message, see fig.11A, col.15 lines 41-51) for modifying an e-mail addressed to a plurality of addressees (e-mail recipients) and sent to a predefined server (200 fig.2) (see col.15 line 52 to col.16 line 25).

sending said modification message to said server to modify at least the body of the email sent to (modifying or deleting email message including the body) and stored on said predefined server if the email body has not been accessed on said server by any of addressee (modifying the previous sent email message if the message has not been seen, see fig.11B, col.16 line 61 to col.17 line 22), wherein the modification of said email body occurs at said server (sender's email system) independently of any email processing means associated with each of said addressees (recipients) [enabling sender to modify message or delete a message after the message left the Email Control System to the remote Email Receiver regardless of the sender email programs, see col.6 lines 44-67 and col.18 lines 1-29].

***Claim Rejections - 35 USC § 103***

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

8. Claims 3-10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Nielsen in view of Uchida et al. (hereafter Uchida), U.S. pat. No.6,237,610.

As to claim 3, Nielsen discloses a server (email system 200 fig.2) to be part of an e-mail system, said server being able to receive, from a data network (Internet 200 fig.2), an e-mail comprising an address header and a body by a sender (sender) to a plurality of addressees (recipients), said server comprising:

storing the body of a received e-mail (email system receiving a email message containing X-modify, see col.15 lines 45-52) together with an authentication protection

(authentication protection including in the header of an email message, see col.10 lines 21-51) on said server (Email Control System 200 fig.2).

sending to each addressee (recipient) of said e-mail a notification (confirmation message) containing the access code for accessing said e-mail body (using database 1104 fig.11A to check for a matching entry, see fig.11A, col.15 line 51 to col.16 line 5)

handling a status storage (database 1105 fig.11A) indicating at least whether said e-mail body has been accessed by one of said addressees (maintaining information in the database if the recipient has seen the message, see col.16 lines 6-25).

if a modification message for modifying said e-mail body is received, modifying said e-mail body according to said modification message (modifying or deleting message), if said e-mail body has not been accessed on said server by any of said addressees [modifying the previous sent email message if the message has not been seen, see fig.11B, col.16 line 61 to col.17 line 22], wherein the modification of said email body occurs at said server (sender's email system) independently of any email processing means associated with each of said addressees (recipients) [enabling sender to modify message or delete a message after the message left the Email Control System to the remote Email Receiver regardless of the sender email programs, see col.6 lines 44-67]

Nielsen suggests using an authentication protection to protect the access to email messages (using authentication protection facility in the headers of email message).

Nielsen does not specifically disclose an access code. However, Uchida in the same

broadcasting electronic mails in the Internet discloses an access code, storing an access code as a key for access to the electronic mail, see Uchida's fig.2, col.6 line 54 to col.7 line 24). It would have been obvious to one of the ordinary skill in the art at the time the invention was made to implement an access code in the computer system of Nielsen to protect the privacy of email messages because it would have enabled prevention of enormous traffic at a network caused by distribution of electronic mail (see Uchida's col.3 lines 9-22) and thus protected the privacy of electronic email distribution in a communications network.

As to claim 4, Nielsen discloses sending a message to the sender of said modification message to notify the sender if the modification has been executed or not (using a modify database to track if previously sent messages have been modified, see fig.8C, col.12 lines 39-64 and col.14 lines 45-64).

As to claim 5, Nielsen discloses sending a message to the sender of said e-mail containing authentication information associated to said e-mail (sender storing a modify message including authentication header for providing a previous sent email message, see figs.2, 7B, col.10 lines 21-51). Nielsen suggests using an authentication protection to protect the access to email messages (using authentication protection facility in the headers of email message). Nielsen does not specifically disclose an access code. However, Uchida in the same broadcasting electronic mails in the Internet discloses an access code, storing an access code as a key for access to the electronic mail, see

Uchida's fig.2, col.6 line 54 to col.7 line 24). It would have been obvious to one of the ordinary skill in the art at the time the invention was made to implement an access code in the computer system of Nielsen to protect the privacy of email messages because it would have enabled prevention of enormous traffic at a network caused by distribution of electronic mail (see Uchida's col.3 lines 9-22) and thus protected the privacy of electronic email distribution in a communications network.

As to claim 6, Nielsen discloses downloading said e-mail body to one of said addressee (recipient) providing an authentication and deleting said e-mail body at said server when each one of said addressees has accessed said e-mail body at said server (email system) (modify or deleting a message according to how long the messages have been inactive and checking to see if the messages have been viewed by recipient, see col.12 line 39 to col.13 line 6). Nielsen suggests using an authentication protection to protect the access to email messages (using authentication protection facility in the headers of email message). Nielsen does not specifically disclose an access code. However, Uchida in the same broadcasting electronic mails in the Internet discloses an access code, storing an access code as a key for access to the electronic mail, see Uchida's fig.2, col.6 line 54 to col.7 line 24). It would have been obvious to one of the ordinary skill in the art at the time the invention was made to implement an access code in the computer system of Nielsen to protect the privacy of email messages because it would have enabled prevention of enormous traffic at a network caused by distribution of

electronic mail (see Uchida's col.3 lines 9-22) and thus protected the privacy of electronic email distribution in a communications network.

As to claim 7, Nielsen discloses storing the header of said e-mail and executing an authentication procedure (using an authentication header information in the modify message) when a user tries to access said e-mail body (see figs.2, 6A-6D, 7A, col.7 line 40 to col.8 line 59, col.9 lines 22-67 and col.10 line 21 to col.11 line 43). Nielsen suggests using an authentication protection to protect the access to email messages (using authentication protection facility in the headers of email message). Nielsen does not specifically disclose an access code. However, Uchida in the same broadcasting electronic mails in the Internet discloses an access code, storing an access code as a key for access to the electronic mail, see Uchida's fig.2, col.6 line 54 to col.7 line 24). It would have been obvious to one of the ordinary skill in the art at the time the invention was made to implement an access code in the computer system of Nielsen to protect the privacy of email messages because it would have enabled prevention of enormous traffic at a network caused by distribution of electronic mail (see Uchida's col.3 lines 9-22) and thus protected the privacy of electronic email distribution in a communications network.

As to claim 8, Nielsen discloses storing the header of said e-mail and receiving a modification message (generating required headers after receiving an action message, see col.9 lines 23-42), dedicated to modifying said e-mail header only OR said e-mail

body (modifying said email body) and modifying said e-mail header according to said modification message (modifying or cancel message in the e-mail's header, see figs.7A, col.9 lines 23-67), if said e-mail has not been accessed by any of said addressees (if the message is not viewed by recipient by using a message seen field, see fig.8B, col.10 lines 21-48 and col.12 lines 5-38).

As to claim 9, Nielsen discloses storing the header of said e-mail and sending to said addressees an e-mail containing said e-mail header and said e-mail body after a predefined time period (a week) (deleting email message if it has been inactive for more than a week) and deleting (deleting message) at said server said e-mail header and said e-mail body (see fig.8C, col.12 line 39 to col.13 line 23).

As to claim 10, Nielsen discloses a computer program product to be executed on a server according to claim 3, said computer program code means adapted to perform a method of modifying an email comprising an address header (header field of the message) and a body and sent to a plurality of addressees (recipients), said method comprising:

storing the body of a received e-mail (email system receiving a email message containing X-modify, see col.15 lines 45-52) together with an authentication protection (authentication protection including in the header of an email message, see col.10 lines 21-51) on said server (Email Control System 200 fig.2) and sending to each addressee (recipient) of said e-mail a notification (confirmation message) containing the access

code for accessing said e-mail body (using database 1104 fig.11A to check for a matching entry, see fig.11A, col.15 line 51 to col.16 line 5), handling a status storage (database 1105 fig.11A) indicating at least whether said e-mail body has been accessed by one of said addressees (maintaining information in the database if the recipient has seen the message, see col.16 lines 6-25) and if a modification message for modifying said e-mail body is received, modifying said e-mail body according to said modification message (modifying or deleting email message including the body), if said e-mail body has not been accessed on said server by any of said addressees [modifying the previous sent email message if the message has not been seen, see fig.11B, col.16 line 61 to col.17 line 22], wherein the modification of said email body occurs at said server (sender's email system) independently of any email processing means associated with each of said addressees (recipients) [enabling sender to modify message or delete a message after the message left the Email Control System to the remote Email Receiver regardless of the sender email programs, see col.6 lines 44-67 and col.18 lines 1-29].

Nielsen suggests using an authentication protection to protect the access to email messages (using authentication protection facility in the headers of email message). Nielsen does not specifically disclose an access code. However, Uchida in the same broadcasting electronic mails in the Internet discloses an access code, storing an access code as a key for access to the electronic mail, see Uchida's fig.2, col.6 line 54 to col.7 line 24). It would have been obvious to one of the ordinary skill in the art at the time the invention was made to implement an access code in the computer system of Nielsen to protect the privacy of email messages because it would have enabled

prevention of enormous traffic at a network caused by distribution of electronic mail (see Uchida's col.3 lines 9-22) and thus protected the privacy of electronic email distribution in a communications network.

***Other prior art cited***

9. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.
  - a. Williams, US pat. No.5,675,733: Method for displaying a reception status of electronic messages.
  - b. Aronberg et al, US pat. No.5,933,647: distribution of software in a customized configuration to a computer in network communications.
  - c. Toga, US pat. No.5,987,504: Indirect transfer of information in response to user initial requests.
  - d. Wookey, US pat. No.6,085: Controlling and modifying documents transmitted in the computer network.

***Response to Arguments***

10. Applicant's arguments with respect to claims 1-12 have been considered but are moot in view of the new ground(s) of rejection.

***Conclusion***

11. Claims 1-12 are rejected.
12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Khanh Dinh whose telephone number is (703) 308-8528. The examiner can normally be reached on Monday through Friday from 8:00 A.m. to 5:00 P.m.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Zarni Maung, can be reached on (703) 308-6687. The fax phone number for this group is (703) 872-9306.

*A shortened statutory period for reply is set to expire THREE months from the mailing date of this communication. Failure to response within the period for response will cause the application to become abandoned (35 U. S. C . Sect. 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(A).*

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 305 -9600.



Khanh Dinh  
Patent Examiner  
Art Unit 2151  
9/15/2004